

REMARKS

Claims 1-77 are presently pending; claims have been amended. In the Office Action dated July 10, 2006, the Examiner took the following actions: rejected claims 68-77 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; rejected claim 27 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and particularly claim the subject matter which applicants regard as the invention; rejected claims 1-77 under 35 U.S.C. § 103(a) as being unpatentable over "traditional business model."

The disclosed embodiments of the invention will now be discussed in comparison to the prior art to clarify various distinctions of Applicants' invention over the cited art. Of course, the discussion of the disclosed embodiments, and the discussion of the differences between the disclosed embodiments and the prior art subject matter, do not define the scope or interpretation of any of the claims. Instead, such discussed differences merely help the Examiner appreciate important claim distinctions discussed thereafter.

An embodiment of the disclosed method of conducting transactions includes three entities or persons. Typically, there are one each of: an attorney, the attorney's client and a third-party service provider. In one embodiment, the attorney provides legal services to the client and also refers the client to the third-party service provider. The third-party service provider then arranges to provide another type service to the client and is paid a fee for doing so. In one embodiment, the third-party service provider manages some of the assets or wealth of the client on an ongoing basis. Once the client pays the fees of the third-party service provider, the provider then pays the attorney for the legal services that were previously rendered to the client. As the relationship between the third-party service provider and the client continues, the attorney will typically continue to advise the client as to matters relating to the management of the assets or wealth. Payment for the legal advice and services dispensed in this capacity will further be paid out of the ongoing fees paid to the service provider for the management of the assets or wealth. It should be noted, however, that the advice and legal services are rendered by the attorney for and at the behest of the client. Said another way, the attorney has a relationship with the client and not with the third-party service provider.

This arrangement for the provision of services, legal and otherwise, as well as payment of fees has several advantages. For example, the relationship between the attorney and the client remain independent of the relationship between the client and the third-party service provider. One advantage of this is that the client is free to use one of their existing attorneys. Also, the attorney may independently evaluate the services provided by the third-party service provider and advise the client accordingly which is obviously of benefit to the client. Lastly, the client has the advantage of paying only one set of fees, to the third-party service provider, for both the legal services rendered by the attorney and those rendered by the service provider. Of course, this arrangement is also beneficial to the attorney because it not only allows them to maintain an independent practice, but also to benefit from the overall relationship without running afoul of ethics regulations that prohibit receipt of referral fees.

The “traditional business model” of the admitted prior art discloses a very different scheme for distributing legal and financial services to a client. With reference to Figure 1A, the client 100 and the attorney 110 have a relationship wherein the attorney provides legal services 115 to the client and the client pays fees 118 to the attorney for rendering these services. In the course of providing the legal services 115 to the client, the attorney makes a referral 130 to the client to retain services from a third-party service provider 120. At this point, the client 100 begins a relationship with a third-party service provider 120. In that relationship, the third-party service provider provides a service or other benefit 125 to the client for which the client pays a fee 128 to the third-party service provider. Once the referral has been made to the client, the attorney is no longer involved and does not benefit in any way from the relationship between the client 100 and the third-party service provider 120. Most clearly, the attorney is paid separately by the third-party service provider for the legal services rendered and not directly from the client.

Turning now to the claims, the content of the documents set forth in claims 68-77 are not “non-functional descriptive material” and the rejection of these claims under 35 U.S.C. § 101 should be withdrawn. With regard to claim 68, the documents set forth therein are functional material and not data per se because the documents themselves establish a relationship between entities and this relationship is functional. The relationship that is established by the documents between the client and the attorney, for example, establishes and changes the status of

the attorney with respect to the client. This status did not exist prior to the creation of the documents and, therefore, the documents are clearly functional because they have the function of creating that very relationship. Claim 69 is patentable subject matter because of its dependence on claim 68 which is patentable subject matter. Likewise, claim 70, which is directed to such documents on computer media, encompasses “documents” that are in electronic form instead of in paper form. The functional aspects of these documents are no less powerful on computer media because they still have the effect of establishing a binding relationship between, for example, the attorney and the client. Claim 70 is, therefore, patentable subject matter and as such, claims that depend from claim 70, claims 71-77, also comprise patentable subject matter. Because the content of documents set forth in claims 68-77 are functional material, the rejection of these claims under 35 U.S.C. § 101 should be withdrawn.

The rejection of claim 27 under 35 U.S.C. § 112, second paragraph, is inappropriate and should be withdrawn. Claim 27 provides that the “first entity is selected by the second entity” and that the “third entity [referred] the first entity to the second entity.” It should be noted that a “referral,” according to its common dictionary meaning, is in no way binding on the person or entity receiving the referral. That is, the person or entity who is referred to, for example, a professional is typically still free to ultimately select a different professional. Claim 27 makes it clear that the second entity has the ultimate choice in selecting the first entity since the first entity is “selected by” the second entity. That possibility is not in any way foreclosed by the fact that the third entity referred the second to the first. Claim 27 does, therefore, particularly point out and distinctly claim patentable subject matter and the rejection should be withdrawn.

The combination of the “traditional business model” of the Applicants' disclosed prior art and the knowledge of one of ordinary skill at the time of invention fails to disclose each and every limitation of amended claim 1. Amended claim 1 is directed towards a method of conducting transactions wherein “the third entity [compensates] the first entity.” As was discussed above, the “traditional business model” does not teach or suggest the first entity receiving compensation from the third entity for any act whatsoever. That is, the first entity receives no money from the third entity for providing services to the second entity nor does the first entity receive any money which might be regarded as a “referral fee.” Amended claim 1,

however, requires that “the third entity [compensate] the first entity” for services the first entity provides to the second entity. The Examiner appears to contend that this missing claim limitation, as well as a motivation to combine, is provided by the knowledge of one of ordinary skill at the time of invention.

Such a contention is misplaced, however, at least because the Examiner appears to regard such compensation as a “referral fee.” The first paragraph on page 4, which carries over onto page 5, describes the compensation provided to entity 1 by entity 3 as a “referral fee” in numerous locations. The compensation provided to entity 1 by entity 3 is not, however, a “referral fee” for at least two reasons. First, the plain language of amended claim 1 states that the compensation is for “the first type of service the first entity provides to the second.” Compensating the first entity for that service is not a “referral” fee under any definition of the word referral since it was expressly for “the first type of service.” Said another way, the compensation is for the service and not for the referral. Second, claim 1 has been amended to claim the method action of entity 1 “referring” entity 2 to entity 3 while expressly limiting that action such that entity 1 is expressly “not accepting fees for referring the second entity to the third entity.” This limitation positively limits the act of “referring” and, therefore, limits the claim. Contrary to the position of the Examiner, there is, therefore, no “referral fee.” Without a referral fee, the knowledge of one of ordinary skill with respect to “referral fees” is not relevant for obviousness analysis. Amended claim 1 and claims depending therefrom are, therefore, patentable over the “traditional business model” and the obviousness rejection should be withdrawn.

Just as with amended claim 1, the combination of the “traditional business model” of the Applicants' disclosed prior art and the knowledge of one of ordinary skill at the time of invention fails to disclose each and every limitation of amended claim 37. Amended claim 37 is directed towards a method of providing legal services to a client wherein an “asset management entity [compensates an] attorney for the legal services provided to the client.” The “traditional business model” of the Applicants' disclosed prior art does not teach or suggest the limitation of an “asset management entity compensating [an] attorney for the legal services provided to the client.” The Examiner seems to rely on the knowledge of one of ordinary skill for teaching such

a limitation as well as for a motivation to combine such knowledge with the “traditional business model.” The examiner further relies on the knowledge a person of ordinary skill would have regarding “referral fees.” As was discussed more fully above, the plain language of amended claim 37 makes it clear that the compensation provided to the attorney is not a “referral fee” and therefore any knowledge a person of ordinary skill would have regarding such fees is of no import. In short, the “traditional business model” does not teach each and every claim limitation of amended claim 37 and the Examiner has failed to provide a reference teaching the missing limitations as well as any motivation to combine such teachings. The obviousness rejection should, therefore, be withdrawn.

The obviousness rejections of amended claims 65-67 should be withdrawn because the combination of the “traditional business model” of the Applicants' disclosed prior art and the knowledge of one of ordinary skill at the time of invention fails to disclose each and every limitation of the claim. In particular, the “traditional business model” of the Applicants' disclosed prior art does not teach or suggest the limitation of a “management entity compensating the attorney for legal services provided to the client.” The Examiner only discusses claim 65-67 on page 5 of the Office Action and regards “affiliated memberships.” Language regarding such subject matter is not present in any of claims 65-67. The Examiner has failed to provide a source teaching the limitation of “management entity compensating the attorney for legal services provided to the client.” And although the Applicants believe the Examiner has not provided such a teaching, to the degree such a teaching is indicated, a motivation to combine such a teaching with the “traditional business model” is also not provided. Because the Examiner has failed to provide references that teach each and every limitation of the claims, the obviousness rejections of claim 65-67 should be withdrawn.

The obvious rejection of claim 68 should be withdrawn because the Examiner has failed to provide a combination of references or teachings that cover every limitation of the claim. Indeed, the Examiner has failed to discuss the limitations of claim 68 with any specificity whatsoever. Amended claim 68 is directed towards a system of doing business wherein at least one document specifies “that [an] asset management entity will compensate the attorney for the legal services provided to the client.” It isn't clear from the Office Action if the Examiner

regards claim 68 as being obvious in light of the Applicants' disclosed prior art. In discussing claim 1, the Examiner also seems to be addressing claims with "similar language." Although the Applicants don't necessarily agree that claim 68 has similar language to claim 1, the Applicants will assume the Examiner intends Applicants' disclosed prior art is relevant in rejecting claim 68.

Even under that assumption, however, the "traditional business method" of the Applicants' disclosed prior art fails to teach an asset management entity compensating the attorney. Moreover, the Examiner has failed to provide any other source for such a teaching. With regard to claim 68, the Examiner has taken Official Notice that it is well known to draft contracts for business agreements. While this is no doubt true, such Official Notice fails to provide the missing claim limitations. Because the Examiner has failed to provide a reference that, when combined with the "traditional business method," teaches every element of claim 68, and has failed to provide any motivation to combine such references, the obviousness rejection should be withdrawn.

The obviousness rejection of claim 70 should be withdrawn for the same reasons as claim 68. Claim 70 is directed towards a system of doing business wherein information contained on computer communications media establishes a relationship that includes "the asset management entity compensating the attorney for providing legal services to the client." As with claim 68, it is not clear what prior art the Examiner regards as relevant in rejecting claim 70. But even assuming that the "traditional business method" of the Applicants' disclosed prior art is relied upon, it fails to disclose the limitation of an "asset management entity compensating the attorney for providing legal services to the client." As was discussed above, the Official Notice the Examiner has taken with regard to contracts, whether on paper or electronic media, fails to teach or suggest the limitation of an "asset management entity compensating the attorney for providing legal services to the client." Because the Examiner has failed to provide a reference that, when combined with the "traditional business method," teaches every element of claim 70, and has failed to provide any motivation to combine such references, the obviousness rejection should be withdrawn.

The remaining claims in the application are patentably distinguished over the cited references because of their dependency on patentable independent claims and because of

the additional limitations added by those claims. All of the claims remaining in the application are now clearly allowable. Favorable consideration and a timely Notice of Allowance are earnestly solicited.

Respectfully submitted,

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A handwritten signature in black ink, reading "Edward W. Bulchis". The signature is fluid and cursive, with the first name "Edward" being more prominent and the last name "Bulchis" written in a continuous script.

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